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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte WILLIAM A. KNAUS and RICHARD D. MARKS

Appeal 2009-0552

Application 09/822,261

Technology Center 3600

Oral Hearing Held: April 22, 2009

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

18 ON BEHALF OF THE APPELLANTS:

James Remenick, Esquire
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24 The above-entitled matter came on for hearing on Wednesday, April
25 22, 2009, commencing at 9:00 a.m., at The U.S. Patent and Trademark
26 Office, 600 Dulany Street, Alexandria, Virginia, before Dan Hawkins.

1 MS. BOBO-ALLEN: Calendar No. 40, Appeal No. 2007-4016, Mr.
2 Remenick.

3 JUDGE CRAWFORD: Good morning.

4 MR. REMENICK: Good morning, everyone.

5 JUDGE FETTING: Good morning.

6 JUDGE CRAWFORD: You can begin whenever you want to.

7 MR. REMENICK: Thank you. First, good morning. Thank you for
8 the hearing, but also thank you for the delay. This was scheduled earlier and
9 I requested a delay and it was granted.

10 For the sake of simplicity, we have two cases for a hearing on appeal.
11 The first one is 09822261, and, if acceptable, I'll refer to that as the 261 case,
12 and the second one is 09816152, and I'll, of course, refer to that as the 152
13 case.

14 Very briefly, I don't --

15 JUDGE FETTING: Could you step to the podium?

16 MR. REMENICK: Oh, I'm sorry.

17 JUDGE FETTING: And there's a microphone there.

18 MR. REMENICK: Better. Very briefly, I don't feel it would be
19 helpful to reiterate all the arguments in the appeal brief. What we'd like to
20 do at this hearing is pretty much bring to your attention any additional
21 arguments we had, give you the opportunity to ask me any questions that
22 you might have on the arguments presented. So I'd be happy to take your
23 questions now or afterwards.

24 For now, I will just begin with the comment, the first comment that
25 we feel that two claims, one in each of the cases, the rejections have been
26 overcome. What the Examiner has rejected those cases for were references

1 that we feel do not disclose the invention of the claim. In particular, Claim
2 37, in the 152 case, refers to records which are better than they were
3 obtained from their source. This case is about personal health records,
4 electronic personal health records. And the reference that was cited against
5 us --

6 JUDGE CRAWFORD: Well, where is that in the claim language?

7 MR. REMENICK: In the claim language for Claim 37?

8 JUDGE CRAWFORD: Um-hum. You said better. This is the 152
9 case?

10 MR. REMENICK: Excuse me. The 152 case, correct. And I
11 misspoke. And it's medical records are more accurate and correct as
12 compared to the sources from which the record was obtained.

13 Claim 20 in the 261 case refers to the medical information of at least
14 one record is better than exists at the source from which the medical record
15 was obtained. So we're referring to more accurate and correct, in Claim 37,
16 and better in Claim 20 in the corresponding case.

17 JUDGE FISCHETTI: Is that the result of the vetting process that you
18 also recite at least -- with respect to the 152?

19 MR. REMENICK: It can be, that's correct. That can be a part. What
20 the Examiner cited against us was a reference having to do with the concept
21 that paper records are not as accurate as their copies electronically. So you
22 can take a paper record, scan it in, and that is, according to the Examiner, as
23 accurate as you can get. I'd like to point out two things. One, it's a copy.

24 JUDGE FISCHETTI: Is that Malik? Just to let you know, are we
25 speaking about Malik?

1 MR. REMENICK: Malik and -- there are different rejections for each
2 case.

3 JUDGE FISCHETTI: Okay.

4 MR. REMENICK: Shepherd for the 261 case, and Siegel (phonetic
5 sp.) for the 152 case, and Malik is applied to both. In this instance, I'm
6 referring to Siegel and Shepherd, principally.

7 The concept, though, that the Examiner cited these cases for is the
8 same; that the paper record is not as accurate and correct as the electronic
9 record. And that simply cannot be true. It's a copy. It has not been vetted.
10 It has not been certified. It has not achieved the aspect of non-repudiation.
11 It's a copy. Electronic copies are better than hand copies, granted, but it's
12 still a copy, and it still doesn't achieve the aspects noted in Claims 20 and 37
13 of more accurate and correct and better medical information on the record.
14 We're not talking about the process. In other words, the result is a clearer or
15 more vivid representation of the paper record. The medical information
16 within there is better, more accurate.

17 The second concept I'd like to bring to your attention is -- we've been
18 doing a lot of work on this case and looking over the prosecution history. In
19 the prosecution history of both cases, the 152 case and the 261 case, the
20 Examiner cited against us Siegel for 152, Shepherd for 261, and other
21 corresponding references, trying to get the concept across that, well, these
22 references disclose non-repudiation -- in particular, Shepherd plus Snowden
23 with regard to 261 -- because they say that the record is accurate.

24 These references talk about the importance of accuracy in records.
25 Accuracy is not the attribute of non-repudiation. What we are trying to get
26 across is that non-repudiation is this concept that includes, perhaps as a part,

1 certification; it can include accuracy; it can include the vetting process; but
2 the aspect of non-repudiation means that the record can be relied upon for all
3 purposes at a hospital. These are not compositions of matter, these are
4 medical records created by people. So it's absolutely critical that they have
5 certain information. When you go to the doctor, he will not necessarily use
6 that record because it's different, because it has something associated with it.
7 It just doesn't have the aspect of non-repudiation.

8 JUDGE FISCHETTI: Are you referring to the definition or example
9 that you present in the specification? Because your brief says the definition
10 of non-repudiation, and then the brief goes on to say you are not
11 incorporating this definition in the spec. So we would ask you, then, where
12 in the record would we find the ordinary and customary definition that you
13 apparently are seeking here?

14 MR. REMENICK: The ordinary and customary definition we will go
15 with is the plain meaning of non-repudiation, which means that the medical
16 information in the medical record is -- has the aspect of -- it may be
17 certified, it may be vetted, it may be accurate, but when a record has the
18 aspect of non-repudiation, the physician, the healthcare provider, just simply
19 uses it. It's not a simple check mark on the record that says, I signed this.
20 It's not a simple check mark on the record that says, I hereby transfer it from
21 Hospital A to Hospital B. It is a record that is absolutely useful and primary
22 for the healthcare provider.

23 JUDGE FISCHETTI: Is that in the record anywhere, that definition
24 that you espouse.

25 MR. REMENICK: We do not have an exact definition section in this
26 application. What we use is, we use the plain meaning of the term non-

1 repudiation, and we use non-repudiation throughout the specification in
2 various examples.

3 JUDGE CRAWFORD: Are you saying you didn't define that non-
4 repudiation in the record -- I mean, in the specification?

5 MR. REMENICK: We do not have a separate definition section. We
6 use non-repudiation in its plain meaning. Perhaps I can answer your
7 question a little better with my second point, which is, in the affidavits
8 themselves, we talk about having evidence of conception and reduction of
9 practice of this idea of this invention prior to the filing dates of Siegel and
10 Shepherd and Snowden. And we presented those affidavits to the Examiner.

11 I'd like to point out two things about that. One, the Examiner said, in
12 her response to our affidavits, the affidavits do not contain the words non-
13 repudiation. Correct. We're not disputing that. But the Examiner also said
14 that she was rejecting our claims over Siegel -- 152 over Siegel, 261 over
15 Shepherd and Snowden, because they contain the word accuracy. So in our
16 brief, we said, well, if you're calling non-repudiation accuracy, it's in our
17 affidavits. If it's not simply accuracy, as we're alleging, then the references
18 were improperly applied. So we feel we have a situation.

19 But the second thing, which is more important to bring your attention
20 to now, is some of the concepts which led to the non-repudiation are in the
21 affidavits. And the particular terms I would like to point you to in the
22 context of the affidavit are trusted agent. The trusted agent, as referred to in
23 the affidavit evidence, refers to the person or entity who will retain the non-
24 repudiable records that one can rely upon. It's not just an agent for the
25 patient, it is a trusted agent. So the concept of non-repudiation began there.

1 Other terms that you may find in the affidavits to have this concept, as
2 well, is decision support. Decision support, referring to the medical records,
3 means evaluating the medical records and making a decision as to whether
4 or not these records attain the aspect of non-repudiation. And the third term
5 that may be helpful is reassurance. Reassurance is also throughout the
6 affidavits and talks about the medical records and how does one know that
7 they attained the aspect of non-repudiation unless there's a reassurance. And
8 the context of the affidavits, in combination with these terms, we believe, are
9 helpful in the foundation of establishing the concept of non-repudiation.

10 JUDGE FISCHETTI: The Knauss affidavit, I see, basically, a first-
11 person narrative for about three quarters of a page. Appended to that is an
12 Executive Summary. That would be an appendix to an affidavit, but
13 wouldn't be a first-person narrative, would it, with respect to what Mr.
14 Knaus is attesting to?

15 MR. REMENICK: Excuse me, I'm not following you.

16 JUDGE FISCHETTI: What is the Executive Summary?

17 MR. REMENICK: This entire document is what's presented
18 internally to the members of the assignee of this application to elaborate on
19 exactly what they had as far as a concept they were developing for business
20 purposes. So the executive summary is simply a short summary that one can
21 refer to when -- as opposed to reading the entire document. But it's not
22 intended to replace the entire document, it's just intended to be a short
23 highlight of some of the points. But the entire document is the concept
24 which began as patient direct.

1 JUDGE FISCHETTI: So you're basically saying this affidavit says
2 that the trusted agent is equivalent to your claim term. But I see nothing in
3 the narrative that speaks to that.

4 MR. REMENICK: In the narrative of the executive summary?

5 JUDGE FISCHETTI: Mr. Knaus' words per se.

6 MR. REMENICK: It may not be there. And I'm not saying that
7 trusted agent is equivalent to nonrepudiation. I'm saying the concept of the
8 trusted agent, the concept of a decision support process, the concept of
9 having a reassurance, all as it relates to the analysis and creation of
10 electronic medical records that can be used for purposes, lead one to the
11 aspect of non-repudiation.

12 JUDGE FISCHETTI: The other question I have with respect to these
13 affidavits is, you apparently are seeking to antedate the prior art, correct,
14 using rule 131?

15 MR. REMENICK: Yes.

16 JUDGE FISCHETTI: Okay. I'm trying to find out where I see actual
17 reduction to practice there.

18 MR. REMENICK: We have actual reduction to practice in the
19 embodiment of this being a method and a process and this being a system.
20 So we don't have bricks and mortar, we don't have the creation of a thing or
21 a chemical. What we have here is a process and a system, and the system is
22 embodied in this document.

23 JUDGE CRAWFORD: Do you have evidence that the system was in
24 existence?

25 MR. REMENICK: In existence as an operating server, no.

1 JUDGE FETTING: I'm looking at Claim 37, which is directed to an
2 electronic database, not to an apparatus, not to a method. It says -- you say it
3 says it's more accurate and correct as compared to those sources. I mean,
4 this literally seems to read on just correcting a spelling error. If you have an
5 electronic database in which you've corrected a spelling error, which I would
6 submit goes back probably hundreds of years, correcting spelling errors, that
7 this, correcting a spelling error in the database, would infringe on Claim 37.

8 MR. REMENICK: An excellent point, and one of the points that we
9 appreciated during the prosecution, which allowed us to amend the claim
10 and many other claims to specifically refer to the medical information within
11 the record. Spelling errors are not necessarily, in my view, correction of
12 medical information. Correction of medical information has to do with this
13 individual had a PSA test, gee, it's a pregnant woman; there's something
14 clearly wrong with this record. So correcting the information in the record
15 would be -- a PSA test on a female is useless. So the correction would be an
16 annotation in there that this was the wrong person, this was the wrong test,
17 or something associated those lines.

18 JUDGE FETTING: I'm not sure I'm seeing all of that nuance in this
19 claim.

20 JUDGE CRAWFORD: Now, you could just be correcting the
21 spelling of a drug, for instance.

22 MR. REMENICK: If the drug -- I would agree with that if the
23 spelling error was a correction of the name of one drug to the actual name of
24 another. But a spelling error -- if you spell Lipitor with a U or an O, it's still
25 Lipitor. So you're not correcting the medical information in the record. I

1 agree it's a fine line. But we're talking about the medical information, not
2 the way it's spelled, but the medical information as it pertains to the patient.

3 JUDGE CRAWFORD: I don't think I have any questions.

4 MR. REMENICK: My fourth point, which is very minor, is I wanted
5 to note that Shepherd, which is cited against the 261 application as evidence
6 of the existence of non-repudiation, refers to correcting data in the record,
7 refers to accuracy of data in the record. Shepherd, however, is directed to
8 indicia in the record. In other words, it's not really correcting the medical
9 information in the record at all. What Shepherd is directed to is creating
10 .indicia, in other words, code words or symbols to say this is, to use the term
11 again, a PSA test. PSA test is coded 5412. So if 5412 appears in the
12 medical record, they're not correcting the medical record if it's for the wrong
13 person, they're correcting the number. Oh, somebody put in 5412, that's
14 incorrect. So they're talking about correcting the indicia. That's not quite
15 the same as looking at the medical information contained within the record
16 at all. That has nothing to do with --

17 JUDGE FISCHETTI: Isn't that a form of annotation, though?

18 MR. REMENICK: It is. It is a form of annotation.

19 JUDGE FISCHETTI: Claims 18 through 19 and 31 basically define -
20 - as one of the limitations of vetting as notation or correcting or linking?

21 MR. REMENICK: Linking is very important, and that's an aspect --

22 JUDGE FISCHETTI: Well, the reader would get one of those three,
23 according to how the claim is written, to define vetting. And annotation
24 seems to be something that works --

25 MR. REMENICK: That can be, also, imparted upon the record,
26 putting in linking aspects, putting in notations, putting in corrections.

1 Medical records are a bit different than a magazine. Medical records have to
2 be exactly as the doctor put in. But what the doctor put in or the healthcare
3 professional put into the record is not necessarily correct. And so, this
4 invention is directed to saying, look, when you go to a hospital and they take
5 your health profile, and then you go to another hospital, you've had some
6 sort of chest pain, it might be a heart attack, they redo all the records because
7 they don't know the first hospital from Adam.

8 They wouldn't have to do that if the records had the aspect of
9 nonrepudiation. They would be as accurate as they were put in, but better,
10 more accurate, because in addition to the exact record from Hospital A
11 would be a corresponding note, perhaps from the vetting process, that said,
12 this is incorrect; this is a PSA test; this is a female. This part of the record is
13 an exact copy of what was done at Hospital A, but it is incorrect.

14 I have no other points to bring to your attention and would be happy
15 to take more questions.

16 JUDGE CRAWFORD: Questions?

17 JUDGE FISCHETTI: You know, Claim 40 seemed to have been --

18 MR. REMENICK: Which case? Excuse me.

19 JUDGE FISCHETTI: This is going to be your --

20 MR. REMENICK: Oh, it has to be 152.

21 JUDGE FISCHETTI: It looks like --

22 MR. REMENICK: The business model claim?

23 JUDGE FISCHETTI: It looks like it's the -- it's the 4016 case, your
24 152 case.

25 MR. REMENICK: Yes.

1 JUDGE FISCHETTI: It seems like there were outstanding 112 2nd
2 and 35 U.S.C. § 101 rejections.

3 MR. REMENICK: Correct.

4 JUDGE FISCHETTI: It looks like you waived them. I saw nothing
5 in the brief on that.

6 MR. REMENICK: There was nothing in the brief. We were trying to
7 be pointed in the brief, and that's correct. The business method aspect that
8 we're refuting, if we must, we will go to filing a divisional application and
9 trying to deal with the examiner's issue. We understand that there's a memo
10 from the Patent Office establishing exactly what needs to be said for certain
11 types of business methods, what needs to be said for certain types of
12 software applications, and we will do our very best to comply with that. We
13 don't want to argue that.

14 JUDGE CRAWFORD: Any other questions?

15 JUDGE FISCHETTI: No, I'm good. Thank you.

16 JUDGE FETTING: Okay, I just -- it seems, when we were discussing
17 Claim 37, that you were trying to characterize the nature of the information.
18 The information is ultimately just bits and bytes on a disc. As I'm certain
19 you're aware, we refer to that as nonfunctional descriptive material here in
20 the Office. And so, especially in light of *In re DeGuise* (phonetic sp.), it's
21 not clear why it should matter whether it's medical information, legal
22 information or just the name of somebody. If it's notoriously well-known to
23 correct information, why should one piece of information that's more
24 accurate than another piece of information be patentable?

25 MR. REMENICK: Excellent point, excellent question. And I can try
26 and respond in two different ways, and I think there are more. You used the

1 exact term that the Examiner did, and I do not fault her for doing that, using
2 the term accuracy in replace of non-repudiation. It is not. Non-repudiation
3 is more than accuracy. Accuracy may be a part, but it's not all.

4 JUDGE FETTING: Well, Claim 37 uses the term accurate, no? It's
5 more accurate and correct as compared to those sources.

6 MR. REMENICK: That's right.

7 JUDGE FETTING: So I used -- so the term I used is the term to be
8 using in this particular context?

9 MR. REMENICK: That's correct. But in addition, more. So, when
10 you refer to a copy, when you refer to making a copy of a paper record into
11 an electronic record, it's a copy, and errors creep in. So, we're saying it's
12 more accurate, but we're not saying it's more accurate because it's a more
13 exact copy and the technology allows that, we're saying it's more correct
14 because the medical information contained therein is more correct. In other
15 words, if I can go back to the analogy of the PSA test on the woman,
16 something will be added to the record to say this is wrong. So it's not just
17 bits of information, they're identical --

18 JUDGE FISCHETTI: But that's not in the claim. The claim just says
19 more accurate. That's very broad. And in the Office, as you well know, we
20 construe as broadly as reasonable.

21 MR. REMENICK: I do.

22 JUDGE FISCHETTI: Okay. I have no further questions.

23 JUDGE CRAWFORD: Thank you.

24 MR. REMENICK: Thank you.

25 (Whereupon, the proceedings concluded at 9:43 a.m. on

Appeal 2009-0552
Application 09/822,261

1 April 22, 2009.)